

## **REMARKS/ARGUMENTS**

Claims 1-14 are currently pending in the subject application. The specification and claims 1-14 have been amended for clarification in accordance with the examiner's suggestions. Support for the claim amendments is found throughout the description and figures and more specifically, for example, at paragraphs 28-38 and Fig. 1. Accordingly, no new matter has been added.

### **Oath/Declaration**

The Office Action notes that the Oath and Declaration filed in connection with the application does not state that the person(s) making the oath/declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. § 1.56.

In response, applicants are filing concurrently herewith a new declaration signed by the inventors which contains a statement acknowledging the duty pursuant to 37 C.F.R. § 1.56.

### **Information Disclosure Statement**

The Office Action alleges that the information disclosure statement filed on June 1, 2007 fails to comply with 37 C.F.R. § 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. § 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language.

In response, without conceding the correctness of the examiner's assertion, applicants will submit as necessary a supplemental information disclosure statement which complies with 37 C.F.R. § 1.98(a)(3).

### **Objection to Specification/Drawings**

In the Office Action, the disclosure is objected to because claim numbers are referenced within the specification.

In response, applicant has amended the disclosure to delete claim number references in the specification. Accordingly, applicants respectfully request withdrawal of this objection.

In the Office Action, the drawings were also objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because they allegedly do not include the reference signs 2b, 1.

In response, applicants have corrected the specification in order to delete the references to 2b and 1. Accordingly, applicants respectfully request withdrawal of this objection.

In the Office Action, the drawings were also objected to under 37 C.F.R. § 1.83(a) because they allegedly do not show every feature of the invention specified in the claims.

In response, applicants have amended the claims such that the drawings fully comply with 37 C.F.R. § 1.83(a). Accordingly, applicants respectfully request withdrawal of this objection.

#### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, claims 1-14 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

In response, applicants have amended claims 1-14 for clarification in accordance with the examiner's suggestions. Accordingly, applicants respectfully request withdrawal of this rejection.

#### **Rejection Under 35 U.S.C. 103(a)**

In the Office Action, claims 1, 3-6 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. 6,470,220 ("Kraus, Jr." hereinafter "Kraus") in view of U.S. 6,462,544 ("McKinnon"). Claims 7 and 12 have been held to be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicants respectfully submit that claims 1, 3-6 and 13 are patentable over Kraus and McKinnon for at least the following reasons.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 103. A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to combine references. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005). The Supreme Court has, however, cautioned against the use of "rigid and mandatory

formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention was made. In other words, a hindsight analysis is not allowed. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991). Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970).

More particularly, in order to establish obviousness by combining or modifying the teachings of the prior art to produce the claimed invention, there must be some teaching, suggestion or motivation to do so. See MPEP § 2143.01(I) (*citing In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” MPEP § 2143.01(III) (*citing KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)).

Applicants’ silence on certain aspects of the rejection is by no means a concession as to their propriety. Rather, because the applied art fails to teach or suggest all limitations of the claims, for at least the reasons discussed below, Applicants respectfully submit that the rejections are improper and should be withdrawn.

Kraus teaches detecting and treating tumors by heating magnetic material attached to tumor cells by manipulating a low frequency magnetic material (claim 1; Col 13, Lns. 15-62). As the examiner concedes, Kraus does not teach or otherwise suggest that the region of action situated outside the space surrounding the arrangement having means for generating the magnetic field. In addition, Kraus does not teach or suggest generating a magnetic field such that a first sub-zone having a low magnetic field strength and a second sub-zone having a higher magnetic field strength are formed in the region of action (claims 1-14). Rather Kraus teaches generating a rotating magnetic field using opposing coils. In contrast, the sub-zones in applicants’ claimed invention can be moved relative to each other minus the requirement of any mechanical movements (e.g., para. 10). Moreover, McKinnon does not remedy the deficiencies of Kraus. McKinnon discloses a magnetic resonant imaging apparatus equipped with a magnet assembly positioned under a table or at the end of a table. McKinnon does not teach or

otherwise suggest applicants claimed invention in which magnetic particles in a region of action are influenced via generation of a magnetic field having a spatial pattern of field strength of low and high magnetic fields wherein the sub-zones can be moved relative to each other minus the requirement of any mechanical movements. Accordingly, applicants respectfully submit that no proper combination of Kraus and McKinnon teaches or otherwise suggests all of the elements of claims 1, 3-6 and 13. Applicants respectfully request withdrawal of this rejection.

### **Double Patenting**

In the Office Action, the Examiner rejected claims 1-7 and 12-14 on the ground of provisional double patenting as allegedly claiming the same invention as that of claims 1, 2 and 4-7 of U.S. 7,351,194.

Without agreeing with the Examiner, and in the interest of advancing prosecution and expediting allowance of the present application, a Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) or (d) will be filed upon a Notice of Allowance of claims 1-14.

In addition, applicants deny any statement, position or averment of the examiner that is not specifically addressed by the foregoing argument and response. Any objections, rejections and/or points of argument not addressed would appear to be moot in view of the presented amendments and remarks. However, applicants reserve the right to submit further arguments in support of the above stated position as necessary. No arguments are waived and none of the examiner's statements are conceded.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance of claims 1-14 is earnestly solicited.

Respectfully submitted,

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